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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/823,411

04/12/2004

Scott C. Anderson

003-005-C1

3240

55962 7590 10/20/2008  
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14901 DEVEAU PLACE  
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EXAMINER

SHAY, DAVID M

ART UNIT

PAPER NUMBER

3769

MAIL DATE

DELIVERY MODE

10/20/2008

PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<p align="center"><b>Advisory Action</b> <b>Before the Filing of an Appeal Brief</b></p>	<p><b>Application No.</b> 10/823,411</p>	<p><b>Applicant(s)</b> ANDERSON ET AL.</p>	
	<p><b>Examiner</b> david shay</p>	<p><b>Art Unit</b> 3735</p>	

**--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**

THE REPLY FILED September 22, 2008 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE.

1. ☒ The reply was filed after a final rejection, but prior to or on the same day as filing a Notice of Appeal. To avoid abandonment of this application, applicant must timely file one of the following replies: (1) an amendment, affidavit, or other evidence, which places the application in condition for allowance; (2) a Notice of Appeal (with appeal fee) in compliance with 37 CFR 41.31; or (3) a Request for Continued Examination (RCE) in compliance with 37 CFR 1.114. The reply must be filed within one of the following time periods:

- a) ☐ The period for reply expires \_\_\_\_\_ months from the mailing date of the final rejection.  
b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.

Examiner Note: If box 1 is checked, check either box (a) or (b). ONLY CHECK BOX (b) WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### NOTICE OF APPEAL

2. ☒ The Notice of Appeal was filed on September 22<sup>nd</sup>, 2008. A brief in compliance with 37 CFR 41.37 must be filed within two months of the date of filing the Notice of Appeal (37 CFR 41.37(a)), or any extension thereof (37 CFR 41.37(e)), to avoid dismissal of the appeal. Since a Notice of Appeal has been filed, any reply must be filed within the time period set forth in 37 CFR 41.37(a).

#### AMENDMENTS

3. ☒ The proposed amendment(s) filed after a final rejection, but prior to the date of filing a brief, will not be entered because  
(a) ☒ They raise new issues that would require further consideration and/or search (see NOTE below);  
(b) ☒ They raise the issue of new matter (see NOTE below);  
(c) ☒ They are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or  
(d) ☐ They present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: See Continuation Sheet. (See 37 CFR 1.116 and 41.33(a)).

4. ☐ The amendments are not in compliance with 37 CFR 1.121. See attached Notice of Non-Compliant Amendment (PTOL-324).  
5. ☒ Applicant's reply has overcome the following rejection(s): The double patenting rejection based on U.S. Patent 5,830,214.  
6. ☐ Newly proposed or amended claim(s) \_\_\_\_\_ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).  
7. ☒ For purposes of appeal, the proposed amendment(s): a) ☒ will not be entered, or b) ☐ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.  
The status of the claim(s) is (or will be) as follows:  
Claim(s) allowed: none.  
Claim(s) objected to: none.  
Claim(s) rejected: 83-95.  
Claim(s) withdrawn from consideration: 50-54.

#### AFFIDAVIT OR OTHER EVIDENCE

8. ☐ The affidavit or other evidence filed after a final action, but before or on the date of filing a Notice of Appeal will not be entered because applicant failed to provide a showing of good and sufficient reasons why the affidavit or other evidence is necessary and was not earlier presented. See 37 CFR 1.116(e).  
9. ☐ The affidavit or other evidence filed after the date of filing a Notice of Appeal, but prior to the date of filing a brief, will not be entered because the affidavit or other evidence failed to overcome all rejections under appeal and/or appellant fails to provide a showing a good and sufficient reasons why it is necessary and was not earlier presented. See 37 CFR 41.33(d)(1).  
10. ☐ The affidavit or other evidence is entered. An explanation of the status of the claims after entry is below or attached.

#### REQUEST FOR RECONSIDERATION/OTHER

11. ☒ The request for reconsideration has been considered but does NOT place the application in condition for allowance because:  
See Continuation Sheet.  
12. ☐ Note the attached Information *Disclosure Statement*(s). (PTO/SB/08) Paper No(s). \_\_\_\_\_  
13. ☐ Other: \_\_\_\_\_.

/david shay/  
Primary Examiner, Art Unit 3735

Continuation of 3. NOTE: Added limitations regarding the perimeter of ablating element and closed wall are new issues, possible new matter.

Continuation of 11. does NOT place the application in condition for allowance because: Applicant argues that the finality of the previous office action be reconsidered, citing MPEP 706.07(a), noting that the amendment of priority data is not an acceptable reason for presenting a new grounds of rejection. While this may be so, it seems that applicant's submission of entirely new claims (please note, as of the first office action claims 34-41, 50-54, and 75-82 were pending in the instant application, however, the claims under consideration at the time of the final office action were claims 50-54, and 83-95. As claims 83-95 were prosecuted in the final action, and as claims 83-95 did not exist at the time of the first action on the merits, regardless of the change in priority, the new grounds of rejection was also necessitated by the completely new claims submitted by applicant. Applicant also attempts to allege that the examiners carrying over of the restriction requirement from the parent case to the continuation child case was improper, asserting that "an election in a parent application carries over only in case of a continued prosecution application (CPA). MPEP 819" (emphasis omitted). However, this is clearly not the case. Apparently, the preceding paragraph of MPEP 819, which is repeated here for applicant's convenience, has escaped applicant's notice: "The general policy of the Office is not to permit the applicant to shift to claiming another invention after an election is once made and action given on the elected subject matter. Note that the applicant cannot, as a matter of right, file a request for continued examination (RCE) to obtain continued examination on the basis of claims that are independent and distinct from the claims previously claimed and examined (i.e., applicant cannot switch inventions by way of an RCE as a matter of right)." Thus clearly a CPA is not the only situation where an election carries over from parent to child. It may also interest applicant to see the definitions of "continuation" and "divisional", which are also reproduced here for applicant's convenience: "Continuation Application A continuation is a second application for the same invention (note the use of the singular) claimed in a prior nonprovisional application and filed before the original prior application becomes abandoned or patented." (see MPEP 201.07, parenthetical comments added); and "Divisional Application A later application for an independent or distinct invention, carved out of a pending application and disclosing and claiming only subject matter disclosed in the earlier or parent application, is known as a divisional application or "division." >A divisional application is often filed as a result of a restriction requirement made by the examiner." (see MPEP 201.06). Clearly the purpose of a Continuation application is not to advance the prosecution of an invention which was not prosecuted in the parent application. If this were not the case, the existence of Divisional applications would be superfluous. Assuming the Divisional applications exist for a specific reason (which the examiner maintains is the case), Continuations would not, then be designed to fulfill this function also. With regard to applicant's arguments concerning the anticipation rejections of the claims, these are not convincing as they are directed to the claims as amended, which amendments have not been entered. With regard to the obviousness rejections, applicant argues that the reservoir of Choy is not any of the types of sensors claimed. The examiner freely admits this and submits that this is precisely the reason the claims reciting these limitations were not rejected under section 102 of the statute. Applicant argues that the reservoir of Choy "is adapted to detect when the obstruction is being broken apart" the examiner agrees, and respectfully notes that such a condition would adversely affect "the adequacy of the contact of the suction well to a tissue". Further applicant argues that one of ordinary skill in the art would not incorporate the reservoir of Choy into the present invention. However, since the examiner has nowhere suggested this, this argument is not convincing.